

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES R. GROSS, BRIAN E. BOEHMER, JOHN P. ERSPAMER
and JOHN PERRY BAKER

Application No. 09/774,248

ORDER RETURNING UNDOCKETED APPEAL TO THE EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on April 5, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below:

INFORMATION DISCLOSURE STATEMENT

Appellant filed an Information Disclosure Statement (IDS) on February 4, 2005. A review of the application reveals that the examiner did not properly consider the IDS.

According to the **Manual of Patent Examining Procedure (MPEP)**

§ 609(C) (2) (Rev. 1, Feb. 2000):

Examiners must consider **all** citations submitted in conformance with the rules and this section, and their initials when placed adjacent to the considered citations on the list or in the boxes provided on a form PTO-1449 . . . Those citations not considered by the examiner will have a line drawn through the citation and any citations considered will have the examiner's initials adjacent thereto . . .

. . . .

. . . . If a statement fails to comply with requirements as discussed in this section for an item of information, a line should be drawn through the citation to show that it has not been considered. The other items of information listed that **do** comply with the rules and this section **will** be considered by the examiner and **will** be appropriately initialed [emphasis added].

It is clear from the record that the Information Disclosure Statement was not properly considered by the examiner.

EXAMINER'S ANSWER

Upon procedural review of the Examiner's Answer mailed September 19, 2005, the Answer is deemed non-compliant with the new rules set forth in 37 CFR § 41.39 effective September 13, 2004. The application reveals that the following content is missing from the Examiner's Answer in the order and with the context stated in the Rules:

Section "**(8) Evidence Relied Upon**," fails to list the relevant references applied in the rejections on appeal.

Correction is required pertaining to the headings and content required in the Examiner's Answer.

APPEAL BRIEF

Further review of the application reveals that the Appeal Brief filed on June 24, 2005 does not comply with the new rules under 37 CFR § 41.37(c), which states in-part:

(a)(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.

...
(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:
...

(ix) Evidence appendix. An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) Related proceedings appendix. An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

The following sections are missing from the Appeal Brief filed June 24, 2005:

(10) **Evidence Appendix** as stated in 37 CFR § 41.37(c)(1)(ix); and

(11) **Related Proceedings Appendix** as stated in 37 CFR § 41.37(c)(1)(x).

Also, the "**Summary of the Invention**" contained in the Brief does not provide an explanation of the subject matter defined in each of the independent claims involved in the appeal, which specifically refer to the specification by page and line number and drawings by reference. **See** 37 CFR § 41.37(c)(1)(v).

It is required that a supplemental Appeal Brief be submitted that is in compliance with 37 CFR § 41.37(c). For more information on the Board's new rules, please see the web page:

<http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html>.

Accordingly, it is

ORDERED that the application is returned to the examiner:

(1) for proper consideration of the Information Disclosure Statement filed February 4, 2005, by either initialing the reference, or by drawing a line through the reference not considered;

(2) for notification to appellants in writing of consideration;

(3) to hold the Appeal Brief filed on June 24, 2005, defective in accordance with 37 CFR § 41.37(c);

(4) to notify appellants to file a supplemental Appeal Brief that fully complies with 37 CFR § 41.37;

(5) to vacate the Examiner's Answer mailed September 22, 2005, to consider the supplemental Appeal Brief; and submit a revised Examiner's Answer in accordance with the new rules effective September 13, 2004; and

(6) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By



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